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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/804,690	03/12/2001	Stanley N. Cohen	S93-160/CIP/DIV2/CON	1876
	7590	03/30/2004	EXAMINER	
Bertram Rowland Lumen 2345 Yale Street Suite 200 Palo Alto, CA 94306			YU, MISOOK	
			ART UNIT	PAPER NUMBER
			1642	
DATE MAILED: 03/30/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/804,690

Applicant(s)

COHEN ET AL.

Examiner

MISOOK YU, Ph.D.

Art Unit

1642

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 03 March 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_.

3. ☒ Applicant's reply has overcome the following rejection(s): none.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.


The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 23-27.Claim(s) withdrawn from consideration: 28-49.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

  
LARRY R. HELMS, PH.D.  
PRIMARY EXAMINER

Misook Yu, 3/25/2004

Continuation of 5. does NOT place the application in condition for allowance because: applicant's response did not overcome the written description rejection of reocrd and 103 rejection of record. Applicant argues that the two species disclosed in the specification is sufficient for the claimed genus because those two species are similar and other mammalian species would have similar sequences and applicant also argues that the protein the claimed antibody binds to is transcription factor and the specification discloses various uses of the claimed invention. Applicant also argues that claim 25 should not be included in the written description rejection These arguments have been fully considered but found unpersuasive because the specification does not limit "human TSG 101 protein" to a specific structure such as SEQ ID NO, therefore human TSG 101 protein encompasses unpredictable species such as allelic variants or splicing variant that the specification does not teach what the structure look like.

Applicant argues that Macuer teaches a fragment of TSG101, but does not teach the defined sequence to express the polypeptide, never had the polypeptide, the sequence is a deduced sequence, was not certain the sequence was correct sequence or not, even if making antibody to known sequence is known, it is not certain that the antibody could bind to the wild-type antigen rather than denatured antigen. The claims do not say the antibodies binding to denature protein is excluded from the claimed invention as long as they bind to wild-type mammalian TSG101 protein, claim 23 appears to exclude antibody binds to mutant-type mammalian TSG101 protein. As for Macuer's sequence, it is an partial open reading frame i.e. 82 amino acid sequence CC2 protein, which is identical to amino acid #231 to 312 of instant SEQ ID NO:4 except two amino acids at position #237 and #275. The Board of Patent Appeals and interferences has taken the position that once an antigen has been known, the manufacture of antibodies against it is prima facie obvious. See Ex parte Erlich 22 USPQ2d 1463 (BdPatApp&Int 1992)..